

## REMARKS

This Response is submitted in reply to the Non-Final Office Action dated April 28, 2010. Claims 37 to 48 are pending in the present application. Claims 1 to 36 have been canceled. Claims 37, 41, and 45 are in independent form. Claims 37 to 48 stand rejected. Claims 38, 40, and 44 have been amended. No new matter has been introduced as a result of these amendments, which are not substantive in nature and only correct typographical errors. Entry of the amendments and favorable reconsideration is respectfully requested. Please charge Deposit Account No. 02-1818 for all payments due in connection with this Response.

The Office Action states the following with respect to consideration of three non-patent literature references:

Applicant requests that the Examiner consider (a) Photoshop 6.0 Technical bible, Softbank Publishing Inc., 1st edition, 25 January, 2001, pp. 67- 68; (b) Totte Karaga Shobu!" no Digital Camera Katsuyo technique," Nikkei Zero-One, NIKKEI HOME PUBLISHING, INC., No. 52, 01 September, 2000, pp. 44-57; and (c) "Digital Camera Gazo o Online Print," Nikkei Personal Computing, Nikkei Business Publications, Inc., No. 409, 13 May, 2002, pp. 98-1 05. See Amendment, pg. 8.

Specifically, Applicant states that the references, cited in an Information Disclosure Statement submitted on April 21, 2006, were cited in the PCT search report dated December 28, 2004 which was submitted on April 21, 2006 in the present application, and that this would seem to meet the minimum requirements of 37 CFR 1.98(a)(3) based on the relevant portions cited by the PCT search report. *See Id.*

The Examiner has considered this argument, but believes that the any information cited in an IDS and not considered by the Examiner failed to comply with 37 CFR 1.98(a)(3). First, the Examiner does not believe that the PCT search report, mentioned by the Applicant, is prepared by an individual designated in 37 CFR 1.56(c).

Second, it is the Examiners opinion that PCT search report cited by the Applicant does not meet the requirements of a concise explanation of the relevance of the documents, as required by 37 CFR 1.98(a)(3).

Office Action, page 3 (emphasis added).

Applicant disagrees with this position because the MPEP expressly indicates that a search report or action may be used as a concise statement as required by 37 CFR 1.98(a)(3). Section 609.04(a)(III) of the MPEP states:

Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report.

Clearly, the Examiner's assertion that the Examiner statements cannot satisfy 37 CFR 1.98(a)(3) is inconsistent with the above provision of the MPEP which indicates that the concise explanation of relevance can be satisfied by an Examiner preparing a search report or action which indicates the degree of relevance of a reference.

Accordingly, Applicant respectfully submits that with respect to "Totte Karaga Shobu!" no Digital Camera Katsuyo technique," Nikkei Zero-One, NIKKEI HOME PUBLISHING, INC., No. 52, 01 September, 2000, pp. 44 to 57, and "Digital Camera Gazo o Online Print," Nikkei Personal Computing, Nikkei Business Publications, Inc., No. 409, 13 May, 2002, pp. 98 to 105, the description provided in the International Search Report of "document defining the general state of the art which is not considered to be of particular relevance" is sufficient according the MPEP 609.04(a)(III). Accordingly, these references should be considered for purposes of examination according to 37 CFR 1.98(a)(3). Further, on September 26, 2006, Applicant submitted the Written Opinion of the International Searching Authority dated August 3, 2006, which states the following:

Document 1: JP 10-78618 A (Fuji Photo Film Co., Ltd.), 24 March 1998 & US 5974401 A

Document 2: JP 11-185034 A (Casio Computer Co., Ltd.), 09 July 1999 (Family: none)

Document 3: Photoshop 6.0 Technical Bible, Softbank Publishing Inc., First edition, 25 January 2001, pp. 67-68

## Discussion

Document 1 pertains to a digital print ordering system that uses a network such as the Internet, etc., and says a user uses image processing and ordering software, and image data, after having image processing such as gamma correction applied, is sent to a printer (paragraphs 0044-0045). It also suggests adding image correction processing instruction data as print order data and having image correction processing done by an operator at the printer (paragraph 0062).

A technical means that displays image data, having it contrasted with image data before image processing and the details of a plurality of various corrections, respectively, as contrastive thumbnails and performs the corresponding image processing on the relevant image data according to which thumbnail is selected by a user is well-known user interface art, as described in document 2 and document 3. Employing this as a user interface for entering image correction processing instruction data added to print order data in the system described in document 1 could easily be conceived by a person skilled in the art.

Therefore the inventions of claims 1-18 do not involve an inventive step on account of documents 1-3.

Applicant respectfully submits that the above description provided in the Written Opinion of the International Searching Authority of Photoshop 6.0 Technical Bible, Softbank Publishing Inc., First edition, 25 January 2001, pp. 67-68, satisfies the requirements of 37 CFR 1.98(a)(3) in view of MPEP 609.04(a)(III). Accordingly, Applicant respectfully requests that these references be considered pursuant to 37 CFR 1.98(a)(3) and MPEP 609.04(a)(III).

The Office Action objected to Claims 38, 40, and 44 for informalities. Applicant has amended each of claims 38, 40, and 44 in view of the stated objections. In light of the present amendments, Applicant respectfully submits that the objectionable matter has been addressed and withdrawal of the objections is earnestly requested.

The Office Action rejected Claims 37 to 48 under 35 U.S.C. § 103(a) as being unpatentable in view of U.S. Patent Publication No. 2001/0053247 to Sowinski et al. ("Sowinski") and further in view of U.S. Patent No. 7,236,960 to Manico et al. ("Manico"). Applicant respectfully disagrees with and traverses these rejections.

Regarding independent Claim 37, the Office Action states that paragraph [0127] of Sowinski discloses: “(a) enable a user to select: (i) a predetermined sample image stored in the image database (Sowinski, [0127]);”. However, Applicant respectfully disagrees with this assertion. Specifically, Sowinski fails to disclose, teach, or suggest that a user selects the predetermined image that is used “to generate a plurality of first image-processing selection images based on said predetermined sample image,” or the image stored in the user terminal is used “to generate a plurality of second image-processing-mode-selection images based on said transmitted image” as recited in independent Claim 37.

In Sowinski, the user selects one of a plurality of images based on a “single scene” in varying renditions of, for example, differing color styles. Sowinski, paragraph [0127], Figure 10. However, the user does not select the image (i.e., the “single scene”), which is used to create these varying renditions of the “single scene” that the user chooses from for style preference purposes. Specifically, the portion of Sowinski cited as disclosing this element states:

One embodiment of the first arrangement discussed above is illustrated in FIG. 10. Here the choices are presented as multiple renditions 1004 of a single scene on one screen 1002 with the renditions varying along the named criteria discussed above, and the customer is asked to choose 1006 his/her favorite rendition. After three to five screens, each probing a distinct single scene, the customer's average look/preference choice can be identified and a profile developed accordingly.

Sowinski, paragraph [0127] (emphasis added).

This paragraph, as well as the rest of Sowinski, fails to teach that the user selects a predetermined image, or an image from the user terminal, as recited in independent Claim 37. Specifically, there is no disclosure that the single scene, or any of the three to five “distinct single screen[s]” are selected by the user.

Moreover, as disclosed in paragraphs [0032] and [0033] of the specification of the present application, the user can select an image owned by the user (e.g., “owned image” button in Figure 2) or a sample image prepared in advance by the center server (e.g., “sample image” button in Figure 2). Contrary to the teaching of Sowinski, the option to select an “owned image” allows the user to select a predetermined image or an image stored in the user terminal. In response to this selection by the user, the selected predetermined image or user terminal image is

used to generate a plurality of images, for example, as seen in Figure 3 as 420A, 420B, and 420C.

Accordingly, Applicant respectfully submits that Sowinski fails to disclose, teach, or suggest “at least one memory device storing a plurality of instructions which when executed by the at least one processor, cause the at least one processor to operate with the user terminal, the server and the print system to: (a) enable a user to select one of: (i) a predetermined sample image stored in the image database; or (ii) an image stored in the user terminal; (b) in response to the predetermined sample image being selected: (i) cause the server to generate a plurality of first image-processing-mode-selection images based on said predetermined sample image, each of said first image-processing-mode-selection images being subjected to different image processes; (ii) cause the display device to display each of said generated first image-processing-mode-selection images; (iii) enable the user to select one of the displayed first image-processing-mode-selection images; (iv) in response to one of the displayed image-processing-mode-selection images being selected, cause the server to store a first image processing mode based on said selected first image-processing-mode-selection image; and (v) cause the printer system to execute print processing based on the first image processing mode stored by said server; (c) in response to the image stored in the user terminal being selected: (i) transmit the image stored in the user terminal to the server; (ii) cause the server to generate a plurality of second image-processing-mode-selection images based on said transmitted image, each of said second image-processing-mode-selection images being subjected to different image processes; (iii) cause the display device to display each of said generated second image-processing-mode-selection images; (iv) enable the user to select one of the displayed second image-processing-mode-selection images; (v) in response to one of the displayed second image-processing-mode-selection images being selected, cause the server to store a second image processing mode based on said selection of the displayed second image-processing-mode-selection image; and (vi) cause the printer system to execute print processing based on the second image processing mode stored by said server.”

The Examiner admits that Sowinski fails to disclose all the recited claim features of independent Claim 37, and relies on Manico to cure the deficiencies of Sowinski. However, like Sowinski, Manico fails to disclose, teach, or suggest that a user selects the predetermined image that is used “to generate a plurality of first image-processing selection images based on said

predetermined sample image,” or the image stored in the user terminal is used “to generate a plurality of second image-processing-mode-selection images based on said transmitted image” as recited in independent Claim 37.

Accordingly, Applicant respectfully submits that neither Sowinski nor Manico, nor the system resulting from any combination of Sowinski and Manico disclose, teach, or suggest “at least one memory device storing a plurality of instructions which when executed by the at least one processor, cause the at least one processor to operate with the user terminal, the server and the print system to: (a) enable a user to select one of: (i) a predetermined sample image stored in the image database; or (ii) an image stored in the user terminal; (b) in response to the predetermined sample image being selected: (i) cause the server to generate a plurality of first image-processing-mode-selection images based on said predetermined sample image, each of said first image-processing-mode-selection images being subjected to different image processes; (ii) cause the display device to display each of said generated first image-processing-mode-selection images; (iii) enable the user to select one of the displayed first image-processing-mode-selection images; (iv) in response to one of the displayed image-processing-mode-selection images being selected, cause the server to store a first image processing mode based on said selected first image-processing-mode-selection image; and (v) cause the printer system to execute print processing based on the first image processing mode stored by said server; (c) in response to the image stored in the user terminal being selected: (i) transmit the image stored in the user terminal to the server; (ii) cause the server to generate a plurality of second image-processing-mode-selection images based on said transmitted image, each of said second image-processing-mode-selection images being subjected to different image processes; (iii) cause the display device to display each of said generated second image-processing-mode-selection images; (iv) enable the user to select one of the displayed second image-processing-mode-selection images; (v) in response to one of the displayed second image-processing-mode-selection images being selected, cause the server to store a second image processing mode based on said selection of the displayed second image-processing-mode-selection image; and (vi) cause the printer system to execute print processing based on the second image processing mode stored by said server” as presently recited in Claim 37.

For at least these reasons, it is respectfully submitted that independent Claim 37 is patentably distinguished over Sowinski, either alone or in combination with Manico, and that

Claim 37 is therefore in condition for allowance. Further, independent Claims 41 and 45 each include certain similar elements to independent Claim 37. For reasons similar to those discussed above with respect to independent Claim 37, independent Claims 41 and 45 are each patentably distinguished over Sowinski in view of Manico and are each presently in condition for allowance.

Applicant respectfully submits that each of dependent Claims 38 to 40, 42 to 44, and 46 to 48 depend from one of independent Claims 37, 41, or 45, and are also allowable for the reasons given with respect to Claims 37, 41, and 45, and further because of the additional features recited in these claims. Accordingly, Applicant respectfully submits that all presently pending claims are patentably distinguished over the cited prior art.

An earnest endeavor has been made to place this application in condition for formal allowance, and such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

The Commissioner is hereby authorized to charge deposit account 02-1818 for any fees which are due and owing.

Respectfully submitted,

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